

Appl. Ser. No. 09/857,673

Att. Docket No. 10191/1840

Reply to Office Action of August 1, 2003

REMARKS

Claims 22 to 46 are pending.

Claim 22 and claim 24 have been amended. Support for the amendment to claim 22 is found throughout the specification and at least at page 7, lines 4 to 12 and Figure 2. Claim 24 has been amended to correct a spelling informality.

Applicants thank the Examiner for indicating that the drawings filed on June 7, 2001 have been accepted.

Also, Applicants thank the Examiner for acknowledging the claim for foreign priority and that all copies of the certified copies of the priority documents have been received.

Claims 22, 24, 27, 28, 32 and 40 were rejected under 35 U.S.C. § 102(b) as anticipated by Denlinger et al., U.S. Patent No. 4,021,839.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims.

While the rejections may not be agreed with, to facilitate matters, claim 22, as presented, recites that a “package substrate includes a thinned central area and a remaining thick substrate edge that stabilizes the package substrate and that is used for handling purposes.” Support for this feature is found at least at page 7, lines 4 to 12.

The Denlinger reference does not describe the feature in which a “package substrate includes a thinned central area and a remaining thick substrate edge that stabilizes the package substrate and that is used for handling purposes.” The Denlinger reference states that a diode package includes “a hollow spacer member 12 of dielectric material having two parallel major surfaces 17 and 19 and a hole 15 defined by an inner wall 13” Column 2, lines 66 to 68), and refers to a diode package that includes a spacer member that is not thinned in a central area nor has a thick substrate edge. Hence, Denlinger does not identically describe a package substrate that “includes a thinned central area and a remaining thick substrate edge that stabilizes the package substrate and that is used for handling purposes.”, as recited in claim 22. Accordingly, Applicants submit that claim 22 is patentable over the Denlinger

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reference. Claims 24, 27, 28, 32, and 40 depend on claim 22 and are allowable for at least the same reasons given above for claim 22. It is therefore respectfully requested that the anticipation rejections be withdrawn.

Claim 26, 29 to 31, 33, 34, 36 and 37 were rejected under 35 U.S.C. § 103(a) as unpatentable over Denlinger as applied to claim 22.

As to claims 26, 29 to 31, 33, 36, and 37, the Office Action states that each of these claims contain subject matter that are obvious matters of design choice. It is respectfully submitted that the cases of In re Fine, *supra*, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions that it would have been obvious to modify or combine the references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added).

Accordingly, it is believed and respectfully submitted that the present Office Action offers only conclusory hindsight, reconstruction and speculation, which does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify a reference or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, it is respectfully submitted that the Office must

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provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” -- which is not the case here -- there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab’s invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

Accordingly, there is no evidence that the reference relied upon, whether taken alone, combined or modified, would provide the features and benefits of claims 26, 29 to 31, 33, 36 and 37. Furthermore, claims 26, 29 to 31, 33, 34, 36 and 37 depend on claim 22 and are allowable for at least the same reasons given above for claim 22 (as discussed above in connection with the § 102(b)). It is therefore respectfully submitted that claims 26, 29 to 31, 33, 34, 36 and 37 are allowable for these reasons.

Claims 23, 34, 35, 38 and 39 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Denlinger and Giboney et al., U.S. Patent No. 6,351,027. Applicants respectfully submit that these rejections should be withdrawn for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), the prior art must teach or suggest each element of the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond,

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910 F.2d 831, 834 (Fed. Cir. 1990). Applicants respectfully submit that these criteria for obviousness are not met here.

Claim 23, 34, 35, 38 and 39 depend on claim 22. Consequently, all claim features of claim 22 of the present application that Denlinger and Giboney do not disclose or suggest (as explained above in connection with the § 102(b) rejection) are also not disclosed or suggested with respect to claims 23, 34, 35, 38 and 39 of the present application. Neither Delinger nor Giboney discloses that a “package substrate includes a thinned central area and a remaining thick substrate edge that stabilizes the package substrate and that is used for handling purposes.” Accordingly, claims 23, 34, 35, 38 and 39 are not rendered obvious for at least the reasons given for allowability of claim 22.

As to claims 41 to 44, the Office Action states that each of these claims contain subject matter that are obvious matters of design choice. It is respectfully submitted that the cases of In re Fine and In re Jones make plain that the Office Action’s generalized assertions that it would have been obvious to modify or combine the references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon.

Accordingly, it is believed and respectfully submitted that the present Office Action offers only conclusory hindsight, reconstruction and speculation, which does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify a reference or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

Accordingly, there is no evidence that the reference relied upon, whether taken alone, combined or modified, would provide the features and benefits of claims 41 to 44. Furthermore, claims 41 to 44 depend on claim 22 and are patentable for at least the same reasons given above for claim 22 (as explained above in connection with the § 102(b) and § 103(a)), since the secondary references do not cure the critical deficiencies of the primary reference. It is therefore respectfully submitted that claims 41 to 44 are allowable for these reasons.

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CONCLUSION

In view of the foregoing, it is believed that the objections and rejections have been obviated, and that claims 22 to 46 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, and that the present application issue as early as possible.

Respectfully submitted,
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